UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/813,497	03/17/97	GOLDMAN	R

B3M1/1001

PATENT DEPARTMENT
GRAY CARY WARE AND FREIDENRICH
400 HAMILTON AVENUE
PALO ALTO CA 94301

EXAMINER	
ASSOUAD, P	

ART UNIT	PAPER NUMBER
2414	6

DATE MAILED: 10/01/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/819,497	Goldman
Examiner	**Group Art Unit**
Patrick Assouad	2414

☒ Responsive to communication(s) filed on *Sep 5, 1997*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *68-99* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *68-99* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Claim Objections

1. With respect to the pre-amendment filed 9/5/97, the numbering of claims is not accordance with 37 CFR 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 CFR 1.121(b), they must be renumbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 78-109 been renumbered as 68-99.

Double Patenting

2. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 68-99 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,629,867 published on May 13, 1997. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following: we see a clear broadening of the claims of the aforementioned U.S. Patent by Applicant's replacement of interchangeable words or phrases; for example, a digital database is replaced with a computer memory storing a database, a bridged network with a generic communications network, or the replacement of a plurality of at least several hundred different selections of music by the words a plurality of pieces of music.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 71 and 92-93 are rejected under 35 U.S.C. § 103 as being unpatentable over **RCS Inc.** ("RCS acquires Decision Inc.; Offers Complete Software Solution for Radio Station Programming, Operations", **2/9/1993**) in view of **Culbertson et al. ('481)**.

As per independent claims 71 and 92, **RCS. Inc.** substantially discloses the instant claimed invention.

The differences between the instant claimed invention and that of **RCS. Inc.** are as follows: a) specific programming of the computer system with a sequence of music selection to be played or the defining of a predetermined sequence of pieces of music to be broadcast and b) the interpretation of the claimed disk array for storing a database comprising a plurality of pieces of music.

RCS Inc. (Radio Computing Services Inc.) "is a 14 year old, privately held corporation which pioneered the use of *computer-based music scheduling* [emphasis added]" (pg. 2 of

article). One of its products, MasterControl, is "a computerized air studio...[that] plays music from a CD jukebox or *computer hard disk* [emphasis added]" (pg. 2 of article).

Culbertson et al. teach an automated digital broadcast system. And it should also be noted that a product of **RCS Inc.** is cited by **Culbertson et al.** in col. 2, line 42. The "SELECTOR" program is used to produce a sequential list containing information relating to the songs, artists, disc and track numbers, and time of play for the various selections.

It should also be noted that **RCS Inc.'s** ability to play music from a CD jukebox or *computer hard disk* [emphasis added] (pg. 2 of article) is interpreted by the Examiner (in view of enclosed Reference U, which is the Digital On-Air Studio System from the U.S. Information Agency, Office of Contracts) in its broadest sense; that is, we see that the US Information Agency presently utilizes [*prior to 1/31/94*] the RCS manufactured Broadcast Programming system commercially known as *Selector* and this system provides a *RAID Level V hard-drive* system, [which] stores and retrieves information from its *database*... etc.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the

computerized air studio of **RCS Inc.**, the defining of a predetermined sequence of pieces of music as described in **Culbertson et al.**, and the storage of a plurality of music selections in a disk array simply because: a) all computer-based systems must be programmed to operate effectively, and in a radio station, this programming would include music scheduling; and, b) those skilled in the art recognize the well-known principle that a single hard-disk storage capacity is always finite and can of course be extended by adding one or more disks.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Assouad whose telephone number is (703) 305-3811. The examiner can normally be reached Monday-Thursday from 6:45 AM to 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Todd Voeltz, can be reached at (703) 305-9714.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5359 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

(Note that the Examiner can also be reached for informal communication via the Internet at: *passouad@uspto.gov*)

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Patrick J. Assouad

Melanie Kemper
MELANIE KEMPER
PATENT EXAMINER
ART UNIT 2414